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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,428	10/15/2003	Andreas Seubert	5343	3913
26936	7590	12/09/2004		
SHOEMAKER AND MATTARE, LTD 10 POST OFFICE ROAD - SUITE 110 SILVER SPRING, MD 20910			EXAMINER ZALUKAEVA, TATYANA	
			ART UNIT	PAPER NUMBER
			1713	

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/684,428	SEUBERT ET AL.	
	Examiner	Art Unit	
	Tatyana Zalukaeva	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6 and 8-17 is/are rejected.
- 7) ☒ Claim(s) 3 and 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 1, 9, are objected to because of the following informalities: The recited in claim 1 "provision" should apparently be providing; the recited in claim 9 "Ugelstad" is a German word. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 6, 11, 13-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Regarding claim 6, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

See MPEP § 2173.05(d).

5. Regarding claim 11 it is not clear if the limitation is optional.

6. Regarding claims 13-16, The claim is indefinite if undue experimentation is involved to determine boundaries of protection. This rationale is applicable to polymer "obtainable" by a stated process because any variation in any parameter within the scope of the claimed process would change the polymer produced. One who made or used a polymer made by a process other than the process cited in the claim would have to produce a polymer using all possible parameters within the scope of the claim, and

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then extensively analyze each product to determine if this polymer was obtainable by a process within the scope of the claimed process. Consult *Ex parte Tanksley*, 26 USPQ 2d 1389.

7. Claim 17 provides for the use of polymer particles, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 17 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

8. Applicants are advised that when amended, the claims may be subjected to a restriction/election of species requirement.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 1, 2, 4, 8, 10, 11, 12, are rejected under 35 U.S.C. 103(a) as being unpatentable over JP'07109360, as evidenced by 6,653,252

JP'360 discloses Uniform particle size resin emulsions produced by emulsifying in water at least one rosin ester, **terpene-based resins** and petroleum resins in presence of copolymeric emulsifier. Production of emulsions is effected by emulsifying into water with use of an emulsifier at least one rosin esters, terpene based resins and petroleum resins. The emulsifier is a copolymer produced by copolymerizing (A) 30-70 wt.% of styrenes, (B) 10-50 wt.% of acrylic acid and/or methacrylic acid and (C) 3 to 20

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wt.% of sulphonic acid groups containing monomer, along with (D) less than 30 wt.% of other monomer copolymerizable with (A) - (C). The copolymer has Mw of 2,000 to 100,000, and is used, on a solid basis as its water soluble salt, at ratios of 1 to 20 %wt. against 100 %wt. of the resin on a solid basis. The emulsifier can permit rosin esters, terpene resins or petroleum resins to be emulsified into emulsions in the form smaller uniform particles, with improved stability and water resistance as well as reduced foaming property, being useful in the prod. of paints, adhesives, etc. (abstract)

The disclosure of JP'360 differs from the instant claims by not specifying the porogen ability of a terpene.

Terpenes are known porogen agents, which is evidenced by the disclosure of U.S. Patent 6,653,252, which states that camphor is a pore-forming agent.

Therefore, it would have been obvious to those skilled in the art at the time the invention was made that the terpene of JP'360 performs the function of porogen with the reasonable expectation of success. With regard to the porosity of polymer particles, it is noted that one who performs the steps of a process must necessarily produce all of its advantages. Mere recitation of a newly discovered property or function that is inherently possessed by the things or steps in the prior art does not cause a claim drawn to those things to distinguish over the prior art. *Leinoff v. Louis Milona & Sons, Inc.* 220 USPQ 845 (CAFC 1984).

13. Claims 13-16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Miyake et al (u.S. 4,093,570).

These are the product-by-process claims, wherein the patentability of the product is defined by the product per se, not by the process of its making, consult *In re Thorpe*, 227 USPQ 964 (CAFC 1985), wherein the Examiner rejected product-by-process claims over a product, which although prepared in a different manner, appeared to be the same (prima facie) as the claimed product.

Furthermore, because of the nature of product-by process claims, the Examiner cannot ordinary focus on the precise difference between the claimed product and the disclosed product. It is then Applicants' burden to prove that an unobvious difference exists. See *In re Marosi*, 218 USPQ 289, 292-293 (CAFC 1983).

In the instant case no Graham vs. John Deere analysis was made but rather the test set out in MPEP 706.03(e) and In re Marosi was applied while explaining why the claimed product does not patentably distinguish over the prior art under 35 USC 102/103.

Miyake discloses the porous polymer of N-vinylcarbazole and methyl methacrylate, having an average pore size of 150 A (15 nm) and a pore volume of 1.05 cm³ /g. Polymer is obtained by polymerization of monomersa in the presence of porogen. (col.14, Example 14).

Allowable subject matter

14. Claims 3 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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No prior art of record teaches or suggests the use of linalool and/or combination of linalool and toluene for polymerization of (meth)acrylates.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tatyana Zalukaeva whose telephone number is (571) 272-1115. The examiner can normally be reached on 9:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tatyana Zalukaeva
Primary Examiner
Art Unit 1713



December 6, 2004